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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,008	08/03/2001	Laura C. Devaney	56850US002	8512

32692 7590 09/16/2003

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EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/923,008	<b>Applicant(s)</b> DEVANEY ET AL.	
	<b>Examiner</b> Victor S Chang	<b>Art Unit</b> 1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**P riod for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>0707</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendment and remarks filed on 7/1/2003. Applicants' amendment to claim 1 and cancellation of claims 7-15 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.
4. Applicants' arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

### *Response to Amendment*

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirata et al. (US 5691038) in view of Abe et al. (US 6017610).

Hirata's invention is directed to a cover tape (Abstract). In Fig. 1, Hirata shows that the cover tape comprises a base material 1 and adhesive parts 2 formed on one side of the base material 1 at both edges along the longitudinal direction (column 5, line 64 to column 6, line 1). Hirata also teaches that an antistatic agent may be applied by coating onto or kneaded into the base material 1 (column 6, lines 20-21). In Example 1, Hirata shows a polyester film having a thickness of 25  $\mu\text{m}$  and a width of 9.3 mm was used as a base material (column 11, lines 51-52).

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For claims 1, 3, 5 and 6, it is noted that Hirata lacks the specific teachings of an antistatic coating of polyaniline or polythiophene, the degree of clarity of the tape, and the surface resistance of the tape. However, it is noted that Abe's invention is directed to an economical conductive laminate having antistatic performance even under low humidity, which performance being sufficient to overcome problems caused by static electricity (Abstract). The conductive laminate comprises a polyester substrate (column 1, lines 12-14). Examples of conductive polymers include water dispersed polyaniline, polythiophene, and derivatives of these polymers such as sulfonated polyaniline (column 3, line 67 to column 4, line 7). Abe also discloses that the conductive laminate has a high transparency, and its surface resistance at 25°C, under 15% RH atmosphere is in the range of  $10^6$  -  $10^{12}$  Ohm (column 10, lines 25-34). It should be noted that the polymer backbones of polythiophene and polyaniline are inherently conjugated. Although Abe is silent about the clarity of the conductive coating, it is believed that since the scope of Abe's invention is essentially the same as the instant claimed invention, the degree of clarity of the tape laminate is either inherently disclosed or an obvious optimization. As such, it would have been obvious to one of ordinary skill in the art to modify the antistatic coating of Hirata's cover tape with Abe's antistatic coating composition, motivated by the desire to obtain a cover tape which has a good antistatic performance as taught by Abe.

For claim 2, Hirata teaches that the cover tape 10 may have a release layer 4 superimposed on the upper surface of the base material 1 as shown in Fig. 7 (column 7, lines 39-41).

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For claim 4, it is believed that poly(3,4-ethylenedioxy-thiophene) is an obvious selection of a derivative of polythiophene polymer as taught by Abe (column 3, line 67 to column 4, line 7).

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making cover tapes:

US 5524765 to Gutentag, directed to a cover tape having a pair of strips of parallel pressure sensitive material (Abstract).

US 6171672 to Koike et al., directed to a cover tape which has pressure sensitive adhesives along the edges of tape-shaped substrate (Fig. 1).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300  
1700

*Daniel Zinker*